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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,671	01/21/2004	Loretta E. Allen	84196CF-9	3403
7590	02/07/2006		EXAMINER HENDERSON, MARK T	
Pamela R. Crocker Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			ART UNIT 3722	
DATE MAILED: 02/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/761,671

Applicant(s)

ALLEN ET AL.

Examiner

Mark T. Henderson

Art Unit

3722

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED OFFICE ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 17, 2006 has been entered.

1. Claims 1, 2, 6, and 7 have been amended for further examination. Claims 8, 10, 12 and 13 have been canceled.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 3 recites the limitation "said indicia" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is not understood which indicia ("first machine readable indicia", second machine readable indicia", or both first and second) applicant is referring to.
3. Claim 6 recites the limitation "said machine-readable indicia" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is not clear which "machine-readable indicia" applicant is referring to.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Zeiter et al (6,494,491).

Zeiter et al discloses in Fig. 4, a media comprising: an image-receiving layer (18) on which a first image indicia (12) is formed; a protective overlayer (10) is selectively applied or superimposed over the image-receiving layer (18), wherein the protective overlayer (10) further comprises a second identical image indicia (14) superimposed over the the first image indicia; and wherein both the first and second indicia are machine readable (Col. 2, lines 61-65, wherein to view/read the indicia, IR or UV light from a machine must be used).

In regards to **Claim 2**, the method of forming machine-readable indicia during application of the protective overlayer over the image receiving layer using a thermal head does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a

different process (see MPEP 2113). Therefore, it is inherent to form the machine-readable indicia during any application process.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiter et al (6,494,491) in view of Yamauchi et al.

Zeiter et al discloses a media comprising all the elements as disclosed in Claim 2, and as set forth above. However, Zeiter et al does not disclose wherein either the first or second indicia is transparent; wherein the protective overlayer comprises an IR absorbing dye.

Yamauchi et al discloses in Fig. 31, a media comprising an image-receiving layer (58) on which a first image indicia (52) is formed; a protective overlayer (56) provided over the image-receiving layer (52), wherein the protective overlayer has a second image indicia (54) formed thereon that is machine readable (Col. 4, lines 20-23). Yamauchi et al further discloses wherein

the indicia is transparent so as to allow viewing of the image, and wherein the protective overlayer comprises an IR absorbing dye (Col. 9, lines 29-38).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zeiter et al's media with indicia being transparent and wherein the protective overlayer has IR absorbing dye as taught by Yamauchi et al for providing an alternative means to prevent counterfeiting.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waldhoff in view of Zeiter et al.

Waldhoff discloses in Fig. 2 and 3, a media (16) having a substrate with a protective layer (32) and an adhesive layer (24).

However, Waldhoff does not disclose: an image-receiving layer having a machine readable indicia-thereon; a protective overlayer applied to the image receiving layer to form a second machine readable indicia of varying thickness.

Zeiter et al discloses in Fig. 4, a media comprising: an image-receiving layer (18) on which a first image indicia (12) is formed; a protective overlayer (10) is selectively applied or superimposed over the image-receiving layer (18), wherein the protective overlayer (10) further comprises a second identical image indicia (14) superimposed over the first image indicia; and wherein both the first and second indicia are machine readable (Col. 2, lines 61-65, wherein to view/read the indicia, IR or UV light from a machine must be used).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Waldhoff's media with an image receiving layer, and a protective overlayer as taught by Zeiter et al for the purpose of providing a media having an authentication means for security purposes.

7. Claims 6, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al.

Yamauchi et al discloses in Fig. 31, a media comprising an image-receiving layer (58) on which a first image indicia (52) is formed; a protective overlayer (56) provided over the image-receiving layer (52), wherein the protective overlayer further comprises a second image indicia (54) formed thereon that is machine readable (Col. 4, lines 20-23). Yamauchi et al further discloses wherein the indicia is transparent so as to allow viewing of the image, and wherein the protective overlayer comprises an IR absorbing dye (Col. 9, lines 29-38).

However, Yamauchi et al does not disclose: wherein first and second indicia is machine readable, wherein the machine readable indicia is integrally formed thereon; and wherein the second indicia is integrally formed thereon and is identical in content to, and in register with the first indicia in the image layer.

In regards to **Claims 6 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the machine readable indicia integrally formed on the protective overlayer, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the



art. Therefore, it would have been obvious to make the machine readable indicia integrally formed on the overlayer since applicant has not disclosed the criticality as to the reason why the indicia has to be integrally formed thereon, and invention would function equally as well if the indicia was placed on the overlayer separately.

In regards to **Claims 6 and 7**, the method of using a thermal head to form an image; and the method of the machine-readable indicia being integrally formed during application of the protective overlayer over the image receiving layer does not structurally limit the claim; and . The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious: to use any device to form the image on the image-receiving layer; and form the machine-readable indicia by any application process.

In regards to **Claims 6, 7 and 9**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any type of indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type

of indicia on the protective layer, since applicant has not disclosed the criticality of having a particular indicia, and invention would function equally as well with any type of indicia.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to place the second indicia at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the indicia at any location, since applicant has not disclosed the criticality of the indicia being at a particular location, and invention would function equally as well if the second indicia is placed at any desirable location on the protective overlayer.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-7, 9 and 11 have been considered but are moot in view of the new ground(s) of rejections.

Zeiter et al is now used to disclose a media having two superimposed machine-readable indicium on an image-receiving layer, wherein the protective overlayer further consists of machine readable indicia. Applicant does not state that the protective overlayer had to be one continuous layer with varying degrees of thickness in the layer. The examiner has made the layer (10) and print layer (14) combined to form the protective overlayer, wherein the "protective overlayer" has "varying degrees of thickness".

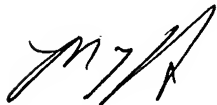
In regards to the method of using a thermal head to form an image; and the method of the machine-readable indicia being integrally formed during application of the protective overlayer over the image receiving layer does not structurally limit the claim; and . The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious: to use any device to form the image on the image-receiving layer; and form the machine-readable indicia by any application process.

Therefore, the examiner's rejection has been maintained.

Art Unit: 3722

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



**BOYER D. ASHLEY**  
**SUPERVISORY PATENT EXAMINER**

MTH

January 28, 2006